



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/802,797

03/18/2004

Masanobu Takashima

Q80126

5076

23373

7590

03/27/2006

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

SHAH, MANISH S

ART UNIT

PAPER NUMBER

2853

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/802,797	Applicant(s) TAKASHIMA ET AL.	
	Examiner Manish S. Shah	Art Unit 2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/12/05; 3/18/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

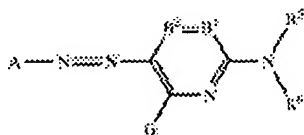
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-4 & 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujiwara et al. (# WO 02/083795).

Fujiwara et al. discloses:

{Claim 1}. An ink-jet recording method using an ink set for forming an image on an ink-jet recording medium ([0193]-[0196]), wherein: the ink-jet recording medium comprises a support and an ink-receiving layer which comprises a sulfur-containing compound ([0196]) and is disposed on the support; the ink set comprises a yellow ink comprising a yellow dye, a magenta ink comprising a magenta dye, and a cyan ink comprising a cyan dye; and the magenta dye has an oxidation potential of higher than 0.8 V (vs SCE) (see Abstract).

{Claim 2}. The magenta dye is represented by the following formula (M-I):

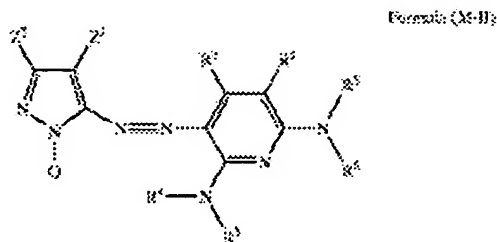


Formula (M-I)

Art Unit: 2853

wherein A represents a residue of a 5-membered heterocyclic diazo component A-NH₂; B1 and B2 represent --CR₁= and --CR₂=, or alternatively one of B1 and B2 represents a nitrogen atom and the other represents --CR₁= or --CR₂=; R5 and R6 each independently represent one selected from the group consisting of a hydrogen atom, aliphatic groups, aromatic groups, heterocyclic groups, acyl groups, alkoxycarbonyl groups, aryloxy carbonyl groups, carbamoyl groups, alkyl or aryl sulfonyl groups, and sulfamoyl groups, and the groups may have a substituent; G, R1 and R2 each independently represent one selected from the group consisting of a hydrogen atom, halogen atoms, aliphatic groups, aromatic groups, heterocyclic groups, a cyano group, a carboxyl group, carbamoyl groups, alkoxycarbonyl groups, aryloxy carbonyl groups, heterocyclyloxy carbonyl groups, acyl groups, a hydroxy group, alkoxy groups, aryloxy groups, heterocyclyloxy groups, silyloxy groups, acyloxy groups, carbamoyloxy groups, alkoxycarbonyloxy groups, aryloxy carbonyloxy groups, amino groups, acylamino groups, ureido groups, sulfamoylamino groups, alkoxycarbonylamino groups, aryloxy carbonylamino groups, alkyl or aryl sulfonylamino groups, heterocyclylsulfonylamino groups, a nitro group, alkyl or aryl thio groups, alkyl or aryl sulfonyl groups, heterocyclylsulfonyl groups, alkyl or aryl sulfinyl groups, heterocyclylsulfinyl groups, sulfamoyl groups, a sulfo group, and heterocyclylthio groups, and the groups may have a substituent; and R1 and R5, or R5 and R6 may bond together to form a 5- or 6-membered ring (page: 9, line: 1-25; page: 10, line: 1-8).

{Claim 3}. The ink-jet recording method of claim 1, wherein the magenta dye is represented by the following formula (M-II):



wherein Z¹ represents an electron-withdrawing group having a Hammett's substituent constant σ_p of 0.20 or more; Z² represents a hydrogen atom, an aliphatic group, an aromatic group, or a heterocyclic group; R¹ and R² each independently represent one selected from the group consisting of a hydrogen atom, halogen atoms, aliphatic groups, aromatic groups, heterocyclic groups, a cyano group, a carboxyl group, carbamoyl groups, alkoxycarbonyl groups, aryloxy carbonyl groups, heterocyclyloxy carbonyl groups, acyl groups, a hydroxy group, alkoxy groups, aryloxy groups, heterocyclyloxy groups, silyloxy groups, acyloxy groups, carbamoyloxy groups, alkoxycarbonyloxy groups, aryloxy carbonyloxy groups, amino groups, acylamino groups, ureido groups, sulfamoylamino groups, alkoxycarbonylamino groups, aryloxy carbonylamino groups, alkyl or aryl sulfonylamino groups, heterocyclylsulfonylamino groups, a nitro group, alkyl or aryl thio groups, alkyl or aryl sulfonyl groups, heterocyclylsulfonyl groups, alkyl or aryl sulfinyl groups, heterocyclylsulfinyl groups, sulfamoyl groups, a sulfo group, and heterocyclylthio groups, and the groups may have a substituent; R³ and R⁴ each independently represent one selected from the group consisting of a hydrogen atom, aliphatic groups, aromatic groups, heterocyclic groups, acyl groups, alkoxycarbonyl groups, aryloxy carbonyl groups, carbamoyl groups, alkyl or aryl sulfonyl groups, and sulfamoyl

Art Unit: 2853

groups; R5 and R6 each independently represent one selected from the group consisting of a hydrogen atom, an aliphatic group, an aromatic group, a heterocyclic group, an acyl group, an alkoxycarbonyl group, an aryloxy carbonyl group, a carbamoyl group, an alkyl or aryl sulfonyl group, and a sulfamoyl group, and the groups may have a substituent; and Q represents a hydrogen atom, an aliphatic group, an aromatic group, or a heterocyclic group (page: 10, line: 9-25; page: 11, line: 1-3).

{Claim 4}. The ink-jet recording method of claim 3, wherein Z1 is one selected from the group consisting of acyl groups having 2 to 20 carbon atoms, alkyloxy carbonyl groups having 2 to 20 carbon atoms, a nitro group, a cyano group, alkylsulfonyl groups having 1 to 20 carbon atoms, arylsulfonyl groups having 6 to 20 carbon atoms, carbamoyl groups having 1 to 20 carbon atoms, and halogenated alkyl groups having 1 to 20 carbon atoms (page: 10, line: 9-25).

{Claim 14}. The ink-jet recording method of claim 1, wherein the ink-receiving layer comprises particles, and the inks are absorbed into spaces between the particles (page: 161, line: 1-25).

{Claim 15}. The ink-jet recording method of claim 1, wherein the ink-receiving layer comprises water-soluble resin, and the inks are absorbed into the water-soluble resin (page: 162, line: 1-15).

{Claim 16}. The ink-jet recording method of claim 1, wherein the ink receiving layer comprises a mordant (page: 162, line: 14-25).

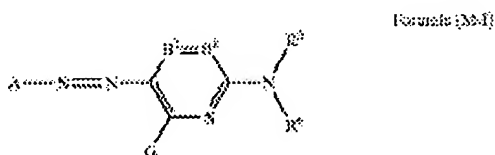
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-16 are rejected under 35 U.S.C. 102(a) as being anticipated by Yabuki (# EP 1340796 A1).

Yabuki discloses:

{Claim 1}. An ink-jet recording method using an ink set for forming an image on an ink-jet recording medium ([0193]-[0196]), wherein: the ink-jet recording medium comprises a support and an ink-receiving layer which comprises a sulfur-containing compound ([0196]) and is disposed on the support; the ink set comprises a yellow ink comprising a yellow dye, a magenta ink comprising a magenta dye, and a cyan ink comprising a cyan dye; and the magenta dye has an oxidation potential of higher than 0.8 V (vs SCE) (see Abstract; [0034]).

{Claim 2}. The magenta dye is represented by the following formula (M-I):

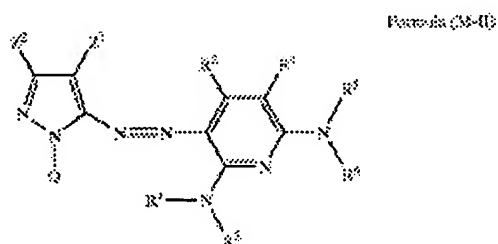


wherein A represents a residue of a 5-membered heterocyclic diazo component A-NH₂; B1 and B2 represent --CR1= and --CR2=, or alternatively one of B1 and B2 represents a nitrogen atom and the other represents --CR1= or --CR2=; R5 and R6 each independently represent one selected from the group consisting of a hydrogen atom, aliphatic groups, aromatic groups, heterocyclic groups, acyl groups, alkoxycarbonyl groups, aryloxycarbonyl groups, carbamoyl groups, alkyl or aryl sulfonyl groups, and sulfamoyl groups, and the groups may have a substituent; G, R1 and R2

Art Unit: 2853

each independently represent one selected from the group consisting of a hydrogen atom, halogen atoms, aliphatic groups, aromatic groups, heterocyclic groups, a cyano group, a carboxyl group, carbamoyl groups, alkoxycarbonyl groups, aryloxycarbonyl groups, heterocyclyloxycarbonyl groups, acyl groups, a hydroxy group, alkoxy groups, aryloxy groups, heterocyclyloxy groups, silyloxy groups, acyloxy groups, carbamoyloxy groups, alkoxycarbonyloxy groups, aryloxycarbonyloxy groups, amino groups, acylamino groups, ureido groups, sulfamoylamino groups, alkoxycarbonylamino groups, aryloxycarbonylamino groups, alkyl or aryl sulfonylamino groups, heterocyclylsulfonylamino groups, a nitro group, alkyl or aryl thio groups, alkyl or aryl sulfonyl groups, heterocyclylsulfonyl groups, alkyl or aryl sulfinyl groups, heterocyclylsulfinyl groups, sulfamoyl groups, a sulfo group, and heterocyclylthio groups, and the groups may have a substituent; and R1 and R5, or R5 and R6 may bond together to form a 5- or 6-membered ring ([0021]).

{Claim 3}. The ink-jet recording method of claim 1, wherein the magenta dye is represented by the following formula (M-II):



wherein Z¹ represents an electron-withdrawing group having a Hammett's substituent constant σ_p of 0.20 or more; Z² represents a hydrogen atom, an aliphatic group, an aromatic group, or a heterocyclic group; R¹ and R² each independently

Art Unit: 2853

represent one selected from the group consisting of a hydrogen atom, halogen atoms, aliphatic groups, aromatic groups, heterocyclic groups, a cyano group, a carboxyl group, carbamoyl groups, alkoxycarbonyl groups, aryloxy carbonyl groups, heterocyclyloxy carbonyl groups, acyl groups, a hydroxy group, alkoxy groups, aryloxy groups, heterocyclyloxy groups, silyloxy groups, acyloxy groups, carbamoyloxy groups, alkoxycarbonyloxy groups, aryloxy carbonyloxy groups, amino groups, acylamino groups, ureido groups, sulfamoylamino groups, alkoxycarbonylamino groups, aryloxy carbonylamino groups, alkyl or aryl sulfonylamino groups, heterocyclylsulfonylamino groups, a nitro group, alkyl or aryl thio groups, alkyl or aryl sulfonyl groups, heterocyclylsulfonyl groups, alkyl or aryl sulfinyl groups, heterocyclylsulfinyl groups, sulfamoyl groups, a sulfo group, and heterocyclylthio groups, and the groups may have a substituent; R3 and R4 each independently represent one selected from the group consisting of a hydrogen atom, aliphatic groups, aromatic groups, heterocyclic groups, acyl groups, alkoxycarbonyl groups, aryloxy carbonyl groups, carbamoyl groups, alkyl or aryl sulfonyl groups, and sulfamoyl groups; R5 and R6 each independently represent one selected from the group consisting of a hydrogen atom, an aliphatic group, an aromatic group, a heterocyclic group, an acyl group, an alkoxycarbonyl group, an aryloxy carbonyl group, a carbamoyl group, an alkyl or aryl sulfonyl group, and a sulfamoyl group, and the groups may have a substituent; and Q represents a hydrogen atom, an aliphatic group, an aromatic group, or a heterocyclic group ([0103]-[0106]).

{Claim 4}. The ink-jet recording method of claim 3, wherein Z1 is one selected from the group consisting of acyl groups having 2 to 20 carbon atoms, alkyloxycarbonyl groups having 2 to 20 carbon atoms, a nitro group, a cyano group, alkylsulfonyl groups having 1 to 20 carbon atoms, arylsulfonyl groups having 6 to 20 carbon atoms, carbamoyl groups having 1 to 20 carbon atoms, and halogenated alkyl groups having 1 to 20 carbon atoms (0103)-(0113)].

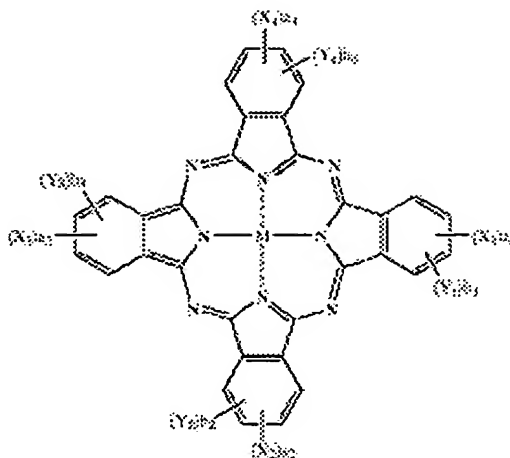
{Claim 5}. The ink-jet recording method of claim 1, wherein the sulfur-containing compound is at least one selected from the group consisting of thioether compounds, thiourea compounds, sulfoxide compounds, thiocyanic acid compounds, sulfinic acid compounds, disulfide compounds, and sulfur-containing heterocyclic compounds.

{Claim 6}. The cyan dye has an oxidation potential of higher than 0.8 V (vs SCE) (see Abstract).

{Claim 7}. The ink-jet recording method claim 6, wherein the sulfur-containing compound is at least one selected from the group consisting of thioether compounds, thiourea compounds, sulfoxide compounds, thiocyanic acid compounds, sulfinic acid compounds, disulfide compounds, and sulfur-containing heterocyclic compounds.

{Claim 8}. The ink-jet recording method of claim 1, wherein the cyan dye is represented by the following formula (C-I):

Example (C-3)



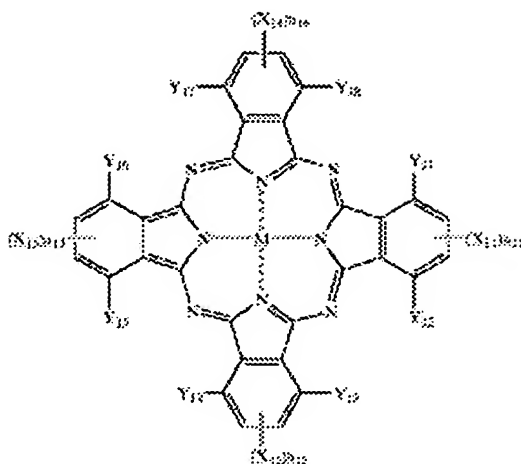
wherein X1, X2, X3 and X4 each independently represent an electron-withdrawing group having a Hammett's substituent constant σ_p of 0.40 or more; Y1, Y2, Y3 and Y4 each independently represent a monovalent substituent; M represents a hydrogen atom, a metal atom, an oxide of a metal atom, a hydroxide of a metal atom, or a halide of a metal atom; a1 to a4 and b1 to b4 are the numbers of X1 to X4 and Y1 to Y4 respectively; a1 to a4 each independently represent an integer from 0 to 4; b1 to b4 each independently represent an integer from 0 to 4; and the sum of a1 to a4 is 2 or more ([0022]).

{Claim 9}. The ink-jet recording method of claim 8, wherein a1 to a4 satisfy $a1=a2=a3=a4=1$ ([0117]).

{Claim 10}. The ink-jet recording method of claim 1, wherein the cyan dye is represented by the following formula (C-II):

Art Unit: 2853

Formula (C-II)



wherein X11 to X14 each independently represent --SO--Z, --SO2--Z, --SO2NR1R2, a sulfo group, --CONR1R2, or --CO2R1; Y11 to Y18 each independently represent a monovalent substituent; M represents a hydrogen atom, a metal atom, an oxide of a metal atom, a hydroxide of a metal atom, or a halide of a metal atom; a11 to a14 are the numbers of X11 to X14 respectively and each independently represent 1 or 2; Z independently represents a substituted or unsubstituted alkyl group, a substituted or unsubstituted cycloalkyl group, a substituted or unsubstituted alkenyl group, a substituted or unsubstituted aralkyl group, a substituted or unsubstituted aryl group, or a substituted or unsubstituted heterocyclic group; and R1 and R2 each independently represent a hydrogen atom, a substituted or unsubstituted alkyl group, a substituted or unsubstituted cycloalkyl group, a substituted or unsubstituted alkenyl group, a substituted or unsubstituted aralkyl group, a substituted or unsubstituted aryl group, or a substituted or unsubstituted heterocyclic group ([0023]).

{Claim 11}. The ink-jet recording method of claim 10, wherein a_{11} to a_{14} satisfy $4 \leq a_{11} + a_{12} + a_{13} + a_{14} \leq 6$ ([0121]).

{Claim 12}. The ink-jet recording method of claim 10, wherein Y₁₁ to Y₁₈ each independently represent one selected from the group consisting of a hydrogen atom, halogen atoms, alkyl groups, aryl groups, a cyano group, alkoxy groups, amide groups, ureido groups, sulfonamide groups, carbamoyl groups, sulfamoyl groups, alkoxycarbonyl groups, a carboxyl group, and a sulfo group (0127)).

{Claim 13}. The ink-jet recording method of claim 10, wherein M is one selected from the group consisting of Cu, Ni, Zn, and Al ([0127]).

{Claim 14}. The ink-jet recording method of claim 1, wherein the ink-receiving layer comprises particles, and the inks are absorbed into spaces between the particles ([0193]-[0207]).

{Claim 15}. The ink-jet recording method of claim 1, wherein the ink-receiving layer comprises water-soluble resin, and the inks are absorbed into the water-soluble resin ([0197]).

{Claim 16}. The ink-jet recording method of claim 1, wherein the ink receiving layer comprises a mordant ([0199]-[0200]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara et al. (# WO 02/083795) in view of Kawasaki et al. (# US 6338891).

Fujiwara et al. discloses all the limitation of the inkjet recording method except that a surface of the ink-receiving layer has a pH value of 3 to 8.

Kawasaki et al. teaches that to get the good color printed image, the surface of the ink-receiving layer has pH value of 4.0 to 5.4 (see Abstract; column: 9, line: 20-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the ink-receiving layer of Fujiwara et al. by the aforementioned teaching of Kawasaki et al. in order to have a good color printed image.

4. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yabuki (# EP 1340796 A1) in view of Kawasaki et al. (# US 6338891).

Yabuki discloses all the limitation of the inkjet recording method except that a surface of the ink-receiving layer has a pH value of 3 to 8.

Kawasaki et al. teaches that to get the good color printed image, the surface of the ink-receiving layer has pH value of 4.0 to 5.4 (see Abstract; column: 9, line: 20-35).

Art Unit: 2853

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the ink-receiving layer of Yabuki by the aforementioned teaching of Kawasaki et al. in order to have a good color printed image.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manish S. Shah whose telephone number is (571) 272-2152. The examiner can normally be reached on 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Manish S. Shah
Primary Examiner
Art Unit 2853

MSS
3/17/06